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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Evan Sundquist
Serial Number: 09/762,781
Filed: 02/13/2001
For: Sheet Wiper

Group Art Unit: 1772
Examiner: Nordmeyer, Patricia

Brief on Appeal

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Pursuant to the Notice of Appeal filed November 24, 2004 Appellants hereby submit the requisite appeal brief.

(i) REAL PARTY IN INTEREST

The real party in interest is CONTEC Inc. located in Spartanburg, South Carolina, USA

(ii) RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences

(iii) STATUS OF CLAIMS

Claims 1, 2, 4, 27, 28 and 29 are pending in this application and are being appealed. Claims 1, 2, 4, 27, 28 and 29 each stand rejected. Claims 3 and 5-26 previously have been withdrawn from consideration pursuant to restriction requirements and are not being appealed.

(iv) STATUS OF AMENDMENTS

No amendments have been filed subsequent to final rejection.

(v) SUMMARY OF CLAIMED SUBJECT MATTER

Independent Claim 1

Claim 1 (from which all other claims depend) claims a wiper cloth as illustrated in FIGS. 2, 4 and 9. As described at page 7, line 22 through page 8, line 1, the wiper cloth is of a hexagonal configuration. As illustrated in FIGS. 2, 4 and 9, the wiper has six contiguous perimeter edges disposed in surrounding relation to an interior portion such that the six contiguous perimeter edges cooperatively define a hexagonal edge boundary extending in substantially continuous unbroken relation around the interior portion.

Means Plus Function or Step Plus Function Recitals

No claim involved in the appeal includes a "means plus function" or "step plus function" recital.

(vi) GROUND FOR REJECTION:

Claims 1, 2, 28 and 29 have been rejected under 35 U.S.C. 103 as being obvious over U.S. Patent 3,784,998 to Jones Sr.. As set forth in the Office Action of November 14, 2003, the Examiner takes the position that even though Jones Sr. fails to disclose a hexagonal edge boundary extending in substantially continuous unbroken relation around the interior portion, since the slits in the pad of Jones Sr. are formed in order to make the handle, one of ordinary skill in the art would have recognized that the

handle is an unnecessary addition and may be removed; thereby removing the need for the slits and forming the claimed unbroken boundary.

Claims 1, 2, 4, 27 and 28 have been rejected under 35 U.S.C. 103 as being obvious over U.S. Patent 6,189,189 to Morin et al.. The Examiner takes the position that since the cited reference states that the wiper may be cut into any geometric shape that it would be obvious to one of skill in the art to form a hexagonal shape as claimed with the motivation being to have a geometrical shape that would appeal to a user. The Office Action also seeks to apply the cases of *In re Seid*, 161 F.2d 229 (CCPA 1947) and *In re Dailey* 357 F.2d 669 (CCPA 1966) for the position that the claimed shape in the present case carries no patentable weight

(vii) ARGUMENT:

Obviousness Over Jones Sr.:

The Office Action admits that Jones Sr. fails to disclose a hexagonal edge boundary extending in substantially continuous unbroken relation around the interior portion as claimed. In order to address this deficiency in the teachings of the cited reference the Office Action takes the position that the slits in the pad of Jones Sr. are present in order to make the handle of the applicator and that one of ordinary skill in the art would recognize that the handle is an unnecessary addition which may be removed, thereby also removing the presence of the slits.

Appellant notes that the Office Action appears to justify the proposed modification solely on the grounds that it would be within the capability of one of skill in the art. That is, the Office Action offers no reason as to why one would make the proposed modification. Appellant respectfully submits that a rejection which is premised on a complete redesign of the article in the cited art with no identified motivation for making the modification fails to satisfy the standards for establishing a proper *prima facie* case of obviousness. Thus, it is submitted that the outstanding obviousness rejection based on Jones Sr. should not be maintained.

It is fundamental that the prior art must suggest the desirability of the claimed invention. See, MPEP §2143.01. In this regard the MPEP clearly indicates that the fact that references can be modified to reach the claimed invention does not render the modification obvious unless the prior art also suggests the desirability of the modification. Importantly for the present case, the MPEP also makes it quite clear that reliance purely on the fact that the proposed modification would be "well within the ordinary skill in the art" is not sufficient to establish the requisite *prima facie* case of obviousness.

Appellant also notes that it is well established that a proposed modification cannot render the prior art unsatisfactory for its intended purpose. Moreover, if the proposed modification would change the principle of operation of the prior art invention being modified then the teachings of the reference are not sufficient to render the claims *prima facie* obvious. See, MPEP § 2143.01. In this regard Appellant notes that if the applicator of Jones Sr. were modified in the manner proposed by the Office Action, the discrete applicator leaves (19) would not be formed within the stacked layers. This would greatly reduce the effective surface area for agent application. In addition, the proposed elimination of the handle would force the user to grasp the body of the applicator which will be saturated with the agent to be applied such as shoe polish, soap or the like. It is respectfully submitted that such a construction would be highly undesirable thereby weighing against any motivation for making the proposed modification. Of course, absent an appropriate motivation for making a proposed modification a *prima facie* case of obviousness cannot be established.

Obviousness Over Morin et al.:

Claims 1, 2, 4, 27 and 28 stand rejected under 35 U.S.C. 103(a) as being obvious over US Patent 6,189,189 to Morin et al.. The rejection is grounded on the fact that Morin et al. states that the low particulate wiper may be of any geometric shape. The Office Action then takes the position that it would have been obvious to use the

claimed hexagonal shape based on the motivation to have a geometric shape that appealed to the user.

In order to support an obviousness rejection the references must be considered as a whole - including portions that lead away from the claimed invention. The prior art must suggest the desirability and thus the obviousness of making the required alteration. Moreover, the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention.

It is respectfully submitted that the Office Action's reliance on the generalized statement in Morin that any geometric shape may be used, represents the application of an impermissible "obvious to try" standard. As explained at MPEP §2145, "obvious to try" is not an appropriate standard in situations wherein the proposition is that it would have been obvious to try numerous possible choices with no guidance from the art until arriving at the claimed invention. This appears to be precisely the situation in the present case. In particular, Morin leaves open the possibility of using any geometry thereby providing an infinite set of choices without providing any guidance as to the fact that geometry may be important let alone any guidance as to how to select an appropriate geometry.

The Office Action takes the position that the instant application does not indicate any new, significant attributes due to its shape that would have been unforeseen to one of ordinary skill in the art. In taking this position the Office Action discounts the benefits of reduced potential for particulate contamination afforded by the claimed invention as explained at page 8 of the written description. The Office Action apparently also discounts the fact that through use of the claimed hexagonal shape these particulate reducing benefits can be obtained while still retaining the ability to avoid fabric waste in the cutting operation as explained at page 11, line 12 through page 12, line 4. In the past constructions, squares and rectangles were used to avoid fabric waste.

The position taken by the Office Action presupposes that the significance of the relationship between area and edge length in controlling particle generation was understood at the time the present invention was made. Appellant must respectfully point out that this position is contradicted by Morin itself which states that the wipers are preferably square. Thus, the statement in Morin that square wipers are preferred reflects the fact that the potential benefits of non-square geometries were unrecognized. Accordingly, there would have been no motivation for engaging in the modification proposed by the Office Action.

MPEP §2141.02 makes it clear that a patentable invention may reside in the identification of the source of a problem even if the remedy is obvious once the source of the problem is identified. This is part of the subject matter as a whole which should always be considered in determining obviousness. As best understood, there is nothing in the art of record to suggest that there was any appreciation for the fact that decreasing edge perimeter relative to interior surface area may lead to decreased particle generation. To the contrary, the statement in Morin et al. that any shape may be used demonstrates that this concept was apparently not given attention.

Finally, as regards the position in the Office Action that a particular shape carries no patentable weight, Appellant notes that the cases cited appear to relate to aesthetic design choices which one of skill in the art would find obvious. These cases do not address situations in which the choice is made to address a previously unrecognized source of a problem as in the present case. At most, it can be argued that one might have chosen the claimed construction. However, absent an understanding of the problem being solved (which does not appear to have been present) one might just have readily chosen any one of an infinite number of other geometries which do not address the problem. As explained above, this represents a classic impermissible "obvious to try" basis for rejection.

Finally, Appellant notes that any choice other than square requires one to ignore the specific recommendations in Morin et al.. It is well established that proceeding

contrary to accepted wisdom is evidence of non-obviousness. In light of the apparent mindset prior to the present invention that square geometries were most desirable, it is respectfully submitted that the present invention may be reached only by application of an impermissible "obvious to try" standard or by hindsight reconstruction using the teachings of the present application as a guide.

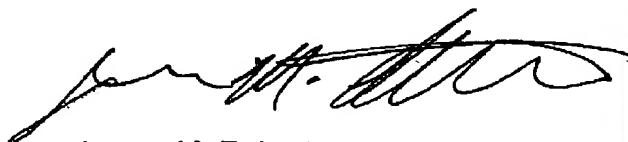
CONCLUSION

For the numerous reasons set forth above, it is respectfully submitted that the cited art does not support a continued rejection of the claimed subject matter. Therefore, reversal of all rejections directed to the identified claims is requested.

A petition for a one (1) month extension of time is provided herewith. To any extent that an additional extension is required, a petition for such an extension is hereby made and authorization is provided to deduct any fee necessary for the acceptance of this paper from Deposit Account 50-1424.

Respectfully submitted,

February 24, 2005



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CLAIM APPENDIX

1. A wiper cloth comprised of a hexagonal sheet material having an interior portion defining two opposing faces and six contiguous perimeter edges disposed in surrounding relation to said interior portion such that the six contiguous perimeter edges cooperatively define an hexagonal edge boundary extending in substantially continuous unbroken relation around said interior portion.
2. The wiper cloth of Claim 1 wherein the six contiguous perimeter edges are of substantially equal length.
4. The wiper cloth of Claim 1 wherein the sheet material is knitted fabric comprised of filament synthetic yarn.
27. The wiper cloth of claim 1 wherein the sheet material comprises a knitted fabric.
28. The wiper cloth of claim 1 wherein the sheet material comprises a woven fabric.
29. The wiper cloth of claim 1 wherein the sheet material comprises a nonwoven fabric.